

REMARKS

This Amendment cancels Claim 10 and adds the limitations therein to independent Claim 1. Claims 1-9 and 11-16 remain in this application.

Claims 1-3, 6 and 16 stand rejected under 35 U.S.C. 102(b) over JP 05-139921 (“Suzuki”). Claims 4-5, 7-9 and 11-15 are rejected under 35 USC 103(a) over the combination of Suzuki with WO 01/26468 (“Senn”).

With regard to the combination of Suzuki and Senn, Applicants respectfully assert that the Office Action has not established a *prima facie* case of obviousness because there is no teaching, motivation or suggestion in either reference to combine the references with one another to arrive at the instantly claimed combination, and because it is only through impermissible hindsight using the Applicants' specification as a guide that one would be motivated to combine the references. (MPEP Section 2142 states that "the tendency to resort to "hindsight" based upon applicant's disclosures is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.")

As noted in MPEP Section 2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed Cir 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed Cir. 1992).

Clearly, there is no such teaching, suggestion or motivation shown in either reference in this case. If the Examiner is relying on knowledge generally available to one of ordinary skill in the art, MPEP Section 2144.03 states that if Applicant traverses such an assertion, and Applicants do in this case, the Examiner should cite a reference in support of his or her position. Applicants hereby request such a reference. If the Examiner is relying on facts within his personal knowledge, Applicants respectfully request and are calling for, pursuant to MPEP Section 2144.03 and 37 C.F.R. Section 104, that the Examiner support such facts by an Affidavit.

Applicants' respectfully caution the Examiner about making conclusory statements not supported by objective evidence. As set forth in the very recent case of *In re Lee*, 61 USPQ2d 1430 (CAFC January 18, 2002):

As applied to the determination of patentability *vel non* when the issue is obviousness, “it is fundamental that rejections under 35 U.S.C. §103 **must be based on evidence** comprehended by the language of that section.” *In re Grasselli*, 713 F.2d 731, 739, 218 USPQ 769, 775(Fed. Cir. 1983). The essential factual evidence on the issue of obviousness is set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966) and extensive ensuing precedent. The patent examination process centers on prior art and the analysis thereof. When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. *See, e.g., McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008(Fed. Cir. 2001) (“the central question is whether there is reason to combine [the] references,” a question of fact drawing on the *Graham* factors).

“The factual inquiry whether to combine references must be thorough and searching.” *Id.* **It must be based on objective evidence of record.** This precedent has been reinforced in myriad decisions, and cannot be dispensed with. *See, e.g., Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) (“a showing of a suggestion, teaching, or motivation to combine the prior art references is an ‘essential component of an obviousness holding’”) (quoting *C.R. Bard, Inc., v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232(Fed. Cir. 1998)); *In re Dembicza*k, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617(Fed. Cir. 1999) (**“Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.”**); *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637(Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600(Fed. Cir. 1988) (“teachings of references can be combined *only* if there is some suggestion or incentive to do so.”) (emphasis in original) (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933(Fed. Cir. 1984)).

The need for specificity pervades this authority. *See, e.g., In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317(Fed. Cir. 2000) (**“particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed”**); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459(Fed. Cir. 1998) (“even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination.”

In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.”; *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783(Fed. Cir. 1992) (**the examiner can satisfy the burden of showing obviousness of the combination “only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary**

skill in the art would lead that individual to combine the relevant teachings of the references").

[2] With respect to Lee's application, neither the examiner nor the Board adequately supported the selection and combination of the Nortrup and Thunderchopper references to render obvious that which Lee described. The examiner's conclusory statements that "the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial" do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion.

Conclusory statements such as those here provided do not fulfill the agency's obligation. This court explained in *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697, that "deficiencies of the cited references cannot be remedied by the Board's general conclusions about what is 'basic knowledge' or 'common sense.'" The Board's findings must extend to all material facts and must be documented on the record, lest the "haze of so-called expertise" acquire insulation from accountability. "Common knowledge and common sense," even if assumed to derive from the agency's expertise, do not substitute for authority when the law requires authority.

The determination of patentability on the ground of unobviousness is ultimately one of judgment. In furtherance of the judgmental process, the patent examination procedure serves both to find, and to place on the official record, that which has been considered with respect to patentability. The patent examiner and the Board are deemed to have experience in the field of the invention; however, this experience, insofar as applied to the determination of patentability, must be applied from the viewpoint of "the person having ordinary skill in the art to which said subject matter pertains," the words of section 103. In finding the relevant facts, in assessing the significance of the prior art, and in making the ultimate determination of the issue of obviousness, the examiner and the Board are presumed to act from this viewpoint. Thus when they rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record. The failure to do so is not consistent with either effective administrative procedure or effective judicial review. The board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.

Emphasis Added

With regard to the 102(b) rejection of the claims over Suzuki, or the combination of Suzukie and Senn for the 103(a) rejection, here again an impermissible form of hindsight is being employed. The machine language translation is so full of sentence fragments and gibberish, that it is not understandable. Only by using the present specification, and looking through the machine language translation for sentence fragments that might seem to support the Office Action's position, could one conclude that the machine language translation teaches anything at all. And certainly, one skilled in the art having only Suzuki would not be motivated to arrive at the present invention, nor to combine it with Senn to arrive at the present invention.

Applicants object to the Examiner's use of a computer-generated translation of this Japanese language document, contending that the translation contains so many grammatical errors and mistranslations as to render it unreliable as a reference for rejecting claims under 35 U.S.C. §§102(b) or 103(a). Tellingly, if the translation was obtained from the Japanese Patent Office, the Japanese Patent Office itself warns that it disclaims any responsibility for "damages caused by the use of this translation" and stating that it, "... may not reflect the original precisely." Applicants respectfully remind the Examiner that as stated in MPEP 901.05(d) he is free to request a translation of a foreign language reference or at least those portions of the reference used in rejecting the claims and urge him to do so.

Appellants object to the Examiner's use of a computer-generated translation of this Japanese language document, contending that such translations contain so many grammatical errors and mistranslations as to render them unreliable as references for rejecting claims under both 35 U.S.C. §§102(b) and 103(a). At most the MPEP might indicate that language reference resources such as machine translations might be used in early stages of prosecution (MPEP 901.05(d), but Applicants were unable to locate any definition in the MPEP of "language reference resources" which embraced machine translations. Further, even if MPEP 901.05(d) allowed the use of such machine language translations, Applicants respectfully request that the Examiner advise as to what point in this prosecution is no longer considered to be in the "early" stages? Is it when a Final Office Action has been received? Is it when, as in the instant case, the application is on appeal to the Board? When it is on appeal to the Federal Circuit? When the application is involved in an Interference proceeding?

The U.S. Patent Office has a group of trained translators for such matters, provided for the benefit of the tax paying public. Applicants request a full and fair translation of

Suzuki before any rejection is made base upon it either alone or in combination with any other reference.

Absent such a translation, Applicants assert the rejections cannot stand and respectfully request withdrawal of the rejections and allowance of the pending claims.

Respectfully submitted,

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